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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,189	11/27/2000	Gerhard Benner	Beiersdorf 670	5654

7590

11/25/2002

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EXAMINER

HAGHIGHATIAN, MINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,189

Applicant(s)

BENNER ET AL.

Examiner

Mina Haghighatian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The rejection of claims 1-3 and 6-11 under 35 U.S.C. 103(a) as being unpatentable over Ascione et al '334 in view of Gohla et al '124 is maintained.

The rejection of claims 4-5 under 35 U.S.C. 103(a) as being unpatentable over Ascione et al '334 in view of Gohla et al '124 as applied to claims 1-3 and 6-11, and further in view of Muller et al '239 is maintained.

The rejection of claims 1-3, 6-7 and 10-11 under 35 U.S.C. 103(a) as being unpatentable over Gohla et al '124 in view of applicant's admission is maintained.

Response to Arguments

Applicant's arguments filed 10/18/02 have been fully considered but they are not persuasive.

Applicant argues that there are additional differences between Ascione et al and the applicant's claimed invention than those cited by the examiner. This may be true, but irrelevant. Applicant is reminded that the claims are drawn to a composition comprising (an open ended language). If the components of the claimed composition are disclosed by the prior art, the claim is considered met by the prior art. Claim 1 contains the following components: an emulsion, an emulsifier and an effective amount of shea butter. The Ascione reference is shown to disclose all of these required

limitations. Claims of the application neither include or exclude other limitations of the Ascione reference. For example instant claims do not exclude DHA in the composition.

Applicant argues that Gohla does not remedy the differences within Ascione and the claimed invention. Applicant further asserts that Gohla teaches their emulsifiers to have HLB value of 11 to 18 which is outside the range of 9.5 to 11.5 of Ascione. However, as is clearly obvious, the HLB value of 11 is present in both ranges and there is an overlap. Also noted is that the 11-18 HLB range is the HLB value of the emulsifier at room temperature. Gohla teaches that HLB values change with the changes in temperature.

Applicant argues that the motivation to combine references is from examiner's assertion, not prior art. Applicant goes on to assert that the neither gohla or Ascione references teach or suggest "producing composition systems which are stable microscopically over relatively long storage times or in wide temperature ranges". Applicant believes that "examiner appears to be making this presumption". However applicant is urged to review both prior art references. In particular lines 41-53 of column 2 in Gohla and lines 9-13 of column 2 of Ascione references. Both references disclose the stability of the emulsion as an objective in their invention.

Applicant argues that all claim limitations are not met. Specifically the amounts of shea butter in claims 3, 8 and 9. This is not correct. Ascione discloses that the oily phase includes oils such as karite butter (shea butter). And the oily phase typically comprises from 5 to 50% by weight. The concentration ranges in claim 3 is 0.1 to 20%

and claims 8 and 9 also fall in the range of 0.5 to 10% and 1 to 5% respectively.

Therefore these limitations are met by the Acsione reference.

Applicant argues that the compositions of Muller are directed toward enhancing the penetration of pharmaceutical active agent through the skin not reducing the stickiness/greasiness of the emulsion. This is not commensurate with the scope of the claims. Again it is noted that the claims are drawn to a composition and their properties and what they do are not the issues.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

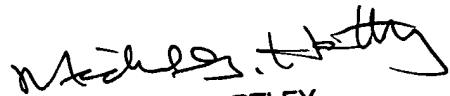
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 703-308-6330. The examiner can normally be reached on core office hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0198.

Mina Haghighatian
November 21, 2002


MICHAEL G. HARTLEY
PRIMARY EXAMINER